ATTACHMENT A
Remarks

Claim Rejections – 35 U.S.C. 103

Claims 1 – 4, 6 – 8, 10 – 17, 19 – 37, 39 – 41, 46 – 48 and 50 – 53 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. (U.S. Patent No. 6,542,943) ("Cheng"). This rejection is respectfully traversed, although several claims have been amended to place the claims into better condition for allowance or appeal. It is respectfully submitted that the amendments to the claims are non-substantive and raise no new issues that require no further searching or prosecution.

Claim 1 has been amended to make it clear that the "download manager" performs the "associating" and "performing a download and installation" steps. This amendment is merely a clarification of what is believed to have been implicit in the previous version of the claim, and, therefore raises no new issues.

Claim 1 recites a method for downloading up to date versions of selected software and installing the software to a hardware unit, including, *inter alia*, associating a transaction identifier with selection data comprising a software selection, wherein the selection data is determined at the time of sale of the hardware unit.

It is alleged in the Office Action that "Cheng discloses a method for downloading substantially up to date versions of selected software" including:

> - associating a transaction identifier with selection data comprising a software selection (see at least col. 7, lines 40 – 43 "a unique registration number to the user. This number may be stored on the client computer 101 and used during subsequent logins to identify the user to the service provider computer 102");

It is acknowledged in the Office Action that "Cheng does not explicitly disclose - said selection data being determined at the time of sale of the hardware unit." However, it is alleged that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to recognize that the selection data (software update) can be determined at any time, at the time of sale of the hardware unit (computer) or any time after that. Further, it is alleged that "one would have been motivated to determine

the selection data (software update) at the time of sale of the hardware unit to ensure that he or she gets the up-to-date software for the purchased hardware unit (computer)."

The four factual inquiries enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) for determining obviousness under 35 U.S.C. 103(a) are: 1) determining the scope and content of the prior art; 2) ascertaining the differences between the prior art and the claims in issue; 3) resolving the level of ordinary skill in the pertinent art; and 4) evaluating evidence of secondary considerations.

Additionally, when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. MPEP 2141.01 II (citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986).

It is respectfully submitted that the teaching in Cheng of a "unique registration number stored on a client computer and used during subsequent logins to identify the user to the service provider computer" is not a teaching of "associating a transaction identifier with selection data comprising a software selection." At best, the cited passage discloses a registration number, which could be read as a transaction identifier. The cited passage certainly does not disclose associating use an identifier with "selection data comprising a software selection."

Further, it is respectfully submitted, as discussed in detail below, that: 1) the claim must be considered as a whole and that "the selection data being determined at the time of sale of the hardware unit" is an integral portion of the method step that cannot be segregated and disposed of merely by alleging that "it would have been obvious to determine selection data at the time of sale of the hardware unit;" 2) that Cheng must be considered as a whole, including the teaching of "analyzing a client computer that is already being used for software products already installed on the computer" and that such a teaching is contrary to a software selection being determined at a time of sale of a hardware unit, as recited in claim 1; and 3) that Cheng must be

viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

As described in the "Background" section of the Application, "PCs are sold or 'bundled' together with a number of software products and services, each of which may be provided by a different software vendor ... difficult for PC vendors to monitor, track down, and obtain latest releases ... users can be irritated and confused ... PC vendors typically bear the brunt of this frustration and thus continually seek ways to deliver new system that are better configured and ready to use 'out of the box.'" "Determining selection data at the time of sale of the hardware unit" provides an "out of the box" solution for providing the latest releases of software products to the customers of such PC vendors.

The determination of selection data "at the time of sale of the hardware unit" is an acknowledged difference between the disclosure of Cheng and the method recited in claim 1. Cheng discloses that a client application analyzes a client computer to determine a list of installed software products on the client computer, determines if there is an applicable update for each of the installed software products, and that the user then selects which software products to update. Col. 7, line 50 – Col. 8, line 35. Considering Cheng as a whole, it is respectfully submitted that Cheng teaches away from predetermining software selection data at the time of sale by, instead, providing that the software selection data is determined by analyzing the client computer, which is already in use and may have installed software, in addition to the software installed on the computer "out of the box," to determine a list of installed software products on the computer, and then requiring the user to select which software products to update. Of course, Cheng provides for "later installed software," but also requires the extra step of analyzing the computer to determine the installed software products and does not predetermine software selection data at the time of sale.

Further, it is noted that no support is provided for the contention that "it would have been obvious ... to recognize that the selection data (software update) can be determined at any time, at the time of sale of the hardware unit (computer) or any time after that." Additionally, it is noted that the suggested motivation of "to ensure that he or she gets the up-to-date software for the purchased hardware unit (computer)" is merely

a paraphrase of the "out of the box" issue described in the Background section of the Application. It is respectfully submitted that, disregarding the teaching of the Application and viewing the issues here as they would be viewed by one of ordinary skill in the art at the time the invention was made when presented with the Cheng reference, that it would not have been obvious to determine the software selection data at the time of sale of the hardware unit. Further, it is respectfully submitted that the reasoning provided in the Office Action for modifying the Cheng reference is based on the improper use of hindsight using the characterization of the problem described in the Specification and the solution as recited in claim 1.

It is respectfully submitted that claims 2 – 4, 6 – 8, 10 – 17, and 19 – 34 depend from claim 1, and are, therefore, allowable for at least the reasons provided in support of the allowability of claim 1.

Additionally, dependent claims 10 and 17 are directed to a software selection that is predetermined. The Cheng reference, as discussed above, discloses analyzing a client computer for a list of already installed software products on the computer in order to determine for which of these products there is an applicable update. It is respectfully submitted that such analysis to determine for which products there is an applicable update is not the same as the "predetermined software selection" recited in claims 10 and 17, in that the latter is predetermined, and thus, by definition, requires no analysis of installed products.

Turning to independent claim 35, claim 35 recites a system for downloading software to a hardware unit from a plurality of vendors over a network, comprising:

> a plurality of software vendor download servers in the network for downloading software from the plurality of software vendors;
>
> a first software handling machine in the network and linked to the hardware unit, the first software handling machine configured to execute a download manager, the download manager adapted to initiate a download/installation transaction comprising selected software to be downloaded to the hardware unit from one or more of the plurality of software vendor download servers, to send a transaction identifier in a download transaction request to a download supervisor over the network, and to download and install the selected software to the hardware unit pursuant to a

download/installation instruction received in response to the download transaction request, said selected software being determined at the time of sale of the hardware unit; and

a second software handling machine in the network configured to execute the download supervisor, the download supervisor adapted to determine whether the download transaction request is authorized, and, in response to determining that the transaction is authorized, to assemble a download/installation instruction comprising up-to-date software access information for the software selection and to send the download/installation instruction to the download manager;

wherein the first software handling machine is linkable to the hardware unit by an external bus, and wherein the download manager executes upon detecting that the hardware unit is linked to the first software handling machine by said external bus.

It is acknowledged in the Office Action that Cheng does not explicitly disclose "wherein the first software handling machine is linkable to the hardware unit by an external bus, and wherein the download manager executes upon detecting that the hardware unit is linked to the first software handling machine by said external bus."

However, Official Notice is taken that "updating an external hardware unit using an external bus to link to a computer is well known to the art." In this regard, it is further stated that [f]or example, updating software to a peripheral device such as a printer, modem, scanner, disk drive, etc. using an external bus to link between the peripheral device and the computer or using one computer to update the software of other computers networked (Internet, intranet, etc)," and that "[o]ne computer first downloads software update from a server or vendors and upon detects that other hardware devices or computers are connected to it, performs software updating to the hardware device."

The Official Notice finding is respectfully traversed. First, it is noted that this Official Notice is being first taken in this final Office Action. Thus, Applicant has not been provided with an opportunity to traverse the finding and request documentary evidence in support of the finding. Second, it is respectfully submitted that "a download manager executing upon detecting that a hardware unit is linked to a first software handing machine by an external bus" is not believed to have been well-known, or common knowledge in the art at the time the invention was made. Thus, it is respectfully

submitted that claim 35, as well as claims 36, 37, 39 – 41 and 53, which depend therefrom, are allowable.

If the Examiner intends to maintain this rejection, it is respectfully requested that the finality of the current Office Action be withdrawn, that documentary evidence supporting the rejection be provided, and that the Applicant be provided with an opportunity to respond.

Further, claim 53 (as well as claim 21) recites an automated kiosk running a point of sale application for allowing a user to select software at the time of sale of the hardware unit, and recording said software selections to said first software handling machine.

It is alleged in the Office Action that Cheng discloses an automated kiosk, as recited, at col. 7, lines 66 – 68, which state "the client application displays 206 the list of applicable software updates to the user, for review and selection thereof of updates for purchase and installation."

As discussed above, the "list of applicable software updates" of the cited passage is generated in response to an analysis of the client computer to determine a list of installed software products, and a determination whether there is an applicable update for each of the installed software products. It is respectfully submitted these steps are performed, by definition, on a client computer that is already being used, and not at the time of sale of a hardware unit. Further, it is respectfully submitted that a kiosk running a point of sale application is neither taught nor suggested by Cheng.

Still further, claim 35 has been amended to include the limitation that "said selected software being determined at the time of sale of the hardware unit," as discussed above with respect to claim 1. Thus, it is respectfully submitted that claims 35 – 37, 39 – 41 and 53 are also allowable for at least the reasons set forth above in support of the allowability of claim 1 with respect to the selected software being determined at the time of sale of the hardware unit.

Independent claim 46 recites a program comprising a storage medium tangibly embodying program instructions operable to cause at least one programmable processor to, *inter alia*, cause a download manager to be preconfigured for downloading a predetermined software selection. It is respectfully submitted that, for the reasons

discussed above with respect to claims 10 and 17, the Cheng reference does not teach or suggest the program recited in claim 46.

Claims 47, 48 and 50 – 52 depend from claim 46 and are allowable for at least the reasons provided in support of the allowability of claim 46.

Claims 5, 9 and 42 – 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in view of DeCosta et al. (U.S. Patent Application Publication No. 2002/0120725) (hereinafter "DeCosta"). This rejection is respectfully traversed, although in the interest of advancing the prosecution of the application, claims 42 – 45 have been amended in a manner that is believed to place the claims into condition for allowance. As discussed below, no new issues are raised by the amendment that would require further consideration or search.

Claims 42 – 45 have been amended to clarify that the subject matter is a "storage medium embodying program instructions," rather than a "program," thus clarifying the statutory nature of the subject matter.

Additionally, claim 42 has been amended to address several potential antecedent basis issues and to recite a storage medium embodying program instructions for implementing a method substantially as recited in claim 1. Thus, it is respectfully submitted that claim 42 is allowable for at least the reasons provided in support of the allowability of claim 1.

Claims 5 and 9 depend from claim 1, as discussed above. It is respectfully submitted that DeCosta does not overcome the deficiencies of claim 1, as discussed above. Therefore, claims 5 and 9 are allowable for at least the reasons provided in support of the allowability of claim 1.

END REMARKS